

REMARKS

The Examiner has rejected the claims at issue for the reasons of record and requests restriction for ten different species, in particular Examiner alleges Group I claims are drawn towards a method of inhibiting ubiquitin isopeptidase in a cell, Group II claims are drawn towards a method of treating an oncological malady in a patient, Group III claims are drawn to a pharmaceutical composition for treating an oncological malady, and Group IV claims are drawn towards methods of treating a disorder mediated by a proteosome pathway, comprising administering to a patient an effective amount of a ubiquitin isopeptidase inhibitor.

Applicants hereby provisionally elect Group I claims drawn to a method of inhibiting ubiquitin isopeptidase in a cell. The claims readable on this election include claims 1-9. Such election has been made with traverse and without prejudice or disclaimer of Applicant's right to traverse similar restrictions in future divisional or continuation applications. The provisional election of the Group I claims should not be construed as an abandonment of the invention of the non-elected claims of Groups II-IV.

Applicants respectfully assert that as a whole, the restriction requirement parsing out four Groups is improper, and that some of the Groups are not independent or distinct or lack unity of invention. In fact, the Examiner has failed to properly explain why any of the Claims Groups are patentably distinct in a way that forces restriction under either PCT Rule 13.2. The Examiner alleges that the general inventive concept that would link these claims is "an inhibitor of ubiquitin isopeptidase," which is further not found to be a

novel feature. This general inventive concept is incorrect, the general linking feature behind all of the listed claims is the USE of ubiquitin isopeptidase inhibitors to inhibit both in a cell, a patient, and a medical oncological condition, the pathway mediated by ubiquitin isopeptidase. As such, applicants contend that each Group necessary relates to the others in a way that requires their prosecution as a whole, and to which is not an unnecessary burden on the Examiner. Applicants respectfully request that the Examiner remove the restriction requirement and prosecute all four of the claims groupings,

Applicant also provisionally selects the punaglandins in claim 8 and PNG6 in claim 9 as the principle species for prosecution as required by examiner, but applicant makes this selection with

traverse. Applicants have listed a valid Markush grouping as allowed by MPEP 2173.05(h). Under MPEP 803.02:

If the members of the Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the examiner must examine all the members of the Markush group in the claim on the merits, even though they may be directed to independent and distinct inventions. In such a case, the examiner will not follow the procedure described below and will not require provisional election of a single species.

Applicant contends such a situation exists in the current claims, the groups are not large and all the members of each group are interrelated in a way that does not increase the Examiner's burden for searching. The Claim 8 compounds are all known classes of

inhibitors of ubiquitin isopeptidase, and the Claim 9 compounds are even more narrowly listed as all members of the punaglandin class. In each instance the groupings are so related that the Examiner's search should not be burdensome. Therefore, Applicant contends the Examiner's requirement for provisional election of a single species is improper and respectfully requests that the Examiner remove this objection and prosecute the claims as listed and in their entirety.

Concluding Remarks

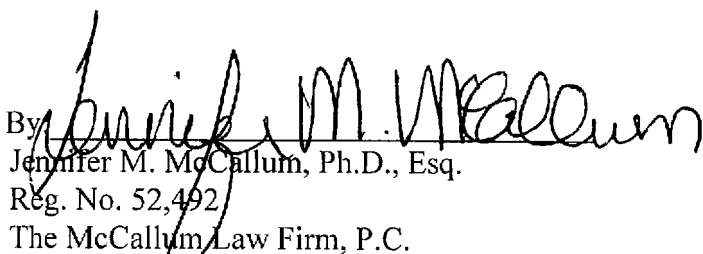
In view of the above provisional election and arguments, an Office Action on the merits is respectfully requested at an early time.

If the Examiner notes any further matters which would be expedited by a telephonic interview, she is requested to contact Dr. Jennifer M. McCallum at the telephone number listed below.

It is believed that no fees are due in this matter; however, if a fee is due the Commissioner is authorized to charge it to deposit account No. 502679.

Respectfully submitted,

3/31/08
Date

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